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Express Mail No. EL 477 836 657 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

NOTICE OF OPPOSITION

In the Matter of Application Serial No.
76/182,471 Published in the Official Gazette
on September 10, 2002 at page TM 341.



04-18-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #74

VIRGIN ENTERPRISES LIMITED,

Opposer,

Opposition No. :

v.

BERRY TEXTILE (SHANGHAI) CO., LTD.,

Attorney Docket No.: 8343-337-999

Applicant.

Assistant Commissioner of Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

S I R:

VIRGIN ENTERPRISES LIMITED ("VEL"), a company organized and existing under the laws of England and Wales with its principal place of business at 120 Campden Hill Road, London W8 7AR, England, believes that it will be damaged by the registration of the designation VIRGINTEX shown in Application Serial No. 76/182,471 for "textiles used in the manufacture of clothing" in International Class 24 and, having previously been given an extension of time to oppose until April 16, 2003, hereby opposes same.

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CERTIFICATION UNDER 37 C.F.R. 1.10

I hereby certify that this paper is being deposited with the United States Postal Service as Express Mail No. EL 477 836 657 US in the envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on April 15, 2003.

Joyce M. Ferraro
(Name)

Joyce M. Ferraro
(Signature)

37,046
(Reg. No.)

April 15, 2003
(Date of Signature)

As grounds of opposition, it is alleged that:

COUNT I

1. Opposer, VEL, and its related companies (collectively, the “Virgin Group”), are now and have for many years been engaged in the sale and distribution of a wide variety of goods and services under the world-famous VIRGIN mark. Sales of its products and provision of its services have been directed to purchasers as well as the trade and the general public.

2. Virgin Group employs more than 25,000 individuals in twenty-six (26) countries worldwide. In the year ending December 31, 1999, Virgin Group companies had worldwide sales revenues of more than U.S. \$5 billion. Goods and services sold or distributed under the VIRGIN mark include, but are not limited to, retail store services, restaurant services, alcoholic and non-alcoholic beverages, processed foods, airline services, transportation services, travel-related services, cargo services, hotel services, telecommunications products and services, graphic art design services, cups, mugs, clothing, cosmetics, luggage, toys, compact disks, computer games, jewelry, clocks, watches, umbrellas, books, television post-production services, records, CDs, audio tapes, videotapes, paper goods, writing instruments, Internet services (including radio), packaging and mailing services, computer media and accessory products, and numerous others.

3. VEL’s licensee, Virgin Atlantic Airways Ltd., has provided VIRGIN and VIRGIN ATLANTIC air travel and related services in U.S. commerce since 1984. Virgin Atlantic operates a fleet of Boeing 747 and Airbus A300 and A340 aircraft providing daily

departures to and from New York (JFK), Newark, Boston, Washington (Dulles), Orlando, Miami, Las Vegas, Los Angeles, and San Francisco.

4. Passengers on board VIRGIN airline flights receive diverse VIRGIN[®] branded items and may purchase, duty-free, VIRGIN sweatshirts, VIRGIN T-shirts, VIRGIN hats, VIRGIN toys, VIRGIN playing cards, VIRGIN clocks, VIRGIN wrist watches, VIRGIN pens, VIRGIN cosmetics, and other VIRGIN branded merchandise.

5. VEL's licensee, Virgin Entertainment Group, Inc., has operated VIRGIN and VIRGIN MEGASTORE retail stores in U.S. commerce since 1992. In the year ending 1999, there were more than 150 VIRGIN MEGASTORE retail stores in major cities of the United States, the United Kingdom, Canada, France, Holland, Austria, Belgium, Norway, Italy, Spain, and Japan. VIRGIN MEGASTORE retail stores sell a broad range of consumer goods including VIRGIN branded clothing and non-VIRGIN branded clothing.

6. By reason of more than thirty (30) years of continuous and substantially exclusive use on a broad range of goods and services distributed throughout the world and tens of millions of dollars spent on advertising and promotion, Opposer's VIRGIN mark has become one of the best-known brand names in international business. Over the past ten (10) years, well-known sources have recognized, acknowledged and published articles concerning this rise to fame.

7. In 1992, Interbrand identified VIRGIN as one of the "world's greatest brands," stating that the "Virgin brand is now established as a broadly-based entertainment and travel brand with a dependable but nonetheless somewhat 'fun' and irreverent image." Advertising Age in 1995 identified VIRGIN as one of "25 rising international brands" along with

such famous brands as ESPN, IKEA, and THE GAP. In 1997, Interbrand identified VIRGIN as one of The World's Top 100 Brands, ranking it 91st in a tie with Canon, just under 90th ranked KLEENEX and above such brands as THE FINANCIAL TIMES, HAAGEN-DAAZ, BRAUN, SAMSUNG, GORDON'S, BENETTON, and DR. MARTENS. This study also ranked VIRGIN fourth among the world's brands having the greatest proven ability to expand or "stretch" across product boundaries into new categories and markets. The 1997 study further listed VIRGIN ATLANTIC as the seventh most important brand in the world in the fields of leisure and travel.

8. Virgin Group companies and their founder, Sir Richard C.N. Branson, have been referred to thousands of times in print and broadcast media disseminated in United States commerce, including feature stories in Time, Newsweek, Business Week, Fortune, and Forbes, and numerous news accounts of Mr. Branson's attempts to circumnavigate the world in a balloon, including appearances on Nightline and the Today Show.

9. Opposer's VIRGIN mark is protected under more than 1,500 trademark and/or service mark registrations in 149 countries.

10. Opposer owns the following VIRGIN trademarks and/or service marks which have been registered with the U.S. Patent and Trademark Office:

<u>Trademark</u>	<u>Registration No.</u>
THE VIRGIN TRADING COMPANY and Logo	2,507,654
VIRGIN	1,413,664
VIRGIN	1,469,618
VIRGIN	1,597,386
VIRGIN	1,851,817
VIRGIN	2,094,460
VIRGIN	2,586,162
VIRGIN	2,625,455
VIRGIN	2,675,758
VIRGIN	2,689,098
VIRGIN (stylized)	1,039,574

<u>Trademark</u>	<u>Registration No.</u>
VIRGIN (stylized)	1,517,801
VIRGIN (stylized)	1,591,952
VIRGIN (stylized)	1,852,776
VIRGIN (stylized)	2,600,080
VIRGIN (stylized)	2,622,510
VIRGIN (stylized)	2,689,097
VIRGIN ATLANTIC VACATIONS	2,482,726
VIRGIN CARGO WINGS	2,488,605
VIRGIN HEALTHCARE FOUNDATION & Design	2,536,973
VIRGIN HOLIDAYS	2,639,079
VIRGIN MEGASTORE	1,863,353
VIRGIN SOL	2,698,986
VIRGIN VACATIONS	2,237,092
VIRGIN VODKA	2,151,589

11. The following registrations cover goods and/or services related to clothing:

- (1) U.S. Registration No. 1,597,386 for VIRGIN for, *inter alia*, “belts, articles of outer clothing, namely, shirts, t-shirts, sweat shirts, jackets, hats, clothing caps, clothing belts”;
- (2) U.S. Registration No. 1,851,817 for VIRGIN for, *inter alia*, “retail store services in the field of clothing”;
- (3) U.S. Registration No. 2,675,758 for VIRGIN for, *inter alia*, “gloves”;
- (4) U.S. Registration No. 1,591,952 for VIRGIN (stylized) for, *inter alia*, “articles of outer clothing, namely, shirts, t-shirts, sweatshirts, hats, clothing caps, clothing belts”;
- (5) U.S. Registration No. 1,852,776 for VIRGIN (stylized) for, *inter alia*, “retail store services in the field of clothing”; and
- (6) U.S. Registration No. 1,863,353 for VIRGIN MEGASTORE for “retail department store services”.

12. Opposer also has pending at the U.S. Patent and Trademark Office, the following applications incorporating its famous VIRGIN mark covering for goods and/or services related to clothing:

- (1) U.S. Application Serial No. 75/979,112 for VIRGIN (stylized) for, *inter alia*, "leisurewear, namely, lounging suits, sweat suits, sweat pants, gym shorts, jogging suits, warm-up suits, fleece bottoms, pullovers and jerseys; articles of underclothing, namely, underpants, pants, camisoles, knickers; articles of outer clothing, namely, waist coats, sweaters, cardigans, leggings; articles of sports clothing, namely, shorts, track suits, swimwear, swimming trunks and leotards"; and
- (2) The divisional application of U.S. Application Serial No. 75/979,112, for which a number has not yet been assigned, for VIRGIN (stylized) for, *inter alia*, "leisurewear, namely, fleece tops and shirts; articles of outer clothing, namely, t-shirts, sweat shirts, jackets, hats and clothing caps" and "retail store services in the field of clothing".

13. Long prior to December 18, 2000, the filing date of Applicant's intent-to-use application, or the December 1, 2000 claimed date of first use, Opposer commenced use of the VIRGIN mark on products distributed and services rendered in the United States. Opposer has continuously used and is currently using the VIRGIN mark in the United States on or in connection with a wide variety of products and services, including those related to textiles and clothing; and continues to expand its business ventures.

14. On December 18, 2000, Applicant filed U.S. Application Serial No. 76/182,471 for VIRGINTEX, based on intent to use and thereafter filed an Amendment to Allege Use claiming use as of December 1, 2000. This application covers "textiles used in the manufacture of clothing" in International Class 24.

15. The use and registration of VIRGINTEX by Applicant for "textiles used in the manufacture of clothing" would be likely to confuse and deceive consumers into thinking that such goods were affiliated with, sponsored by, or connected with VIRGIN, VIRGIN MEGASTORE, and VIRGIN ATLANTIC goods and services offered throughout the United States, including clothing.

16. Applicant's designation VIRGINTEX incorporates Opposer's famous name and mark VIRGIN and, as such, is nearly identical to and invokes Opposer's name and mark VIRGIN.

17. Applicant's designation VIRGINTEX is nearly identical to Opposer's VIRGIN trademarks and service marks.

18. Applicant's goods are related to Opposer's goods and services which it currently markets and sells under its VIRGIN marks.

19. Applicant's designation VIRGINTEX is nearly identical to Opposer's name and mark VIRGIN and Opposer's VIRGIN family of marks comprised of Opposer's name and mark VIRGIN combined with other elements, as to be likely, when applied to Applicant's goods, to cause confusion and mistake and to deceive, with consequent injury to Opposer, the trade and the public.

20. Opposer will be damaged by the registration sought herein by Applicant because such registration will support and assist Applicant in the confusing and misleading use of Applicant's designation sought to be registered, and will give color of exclusive statutory rights in Applicant in violation and derogation of the prior superior rights of Opposer.

COUNT II

21. Opposer repeats and realleges the allegations contained in paragraphs 1 through 20 above as if the same were set forth at length herein.

22. Opposer's VIRGIN family of marks are not only well-known, but also famous as defined in Section 43(c) of the federal Trademark Act, 15 U.S.C. §1125(c)(1).

23. Due to the numerous VIRGIN products and services available in the United States and throughout the world, the registration of Applicant's VIRGINTEX designation is likely to injure Opposer's business reputation and dilute the distinctive quality of Opposer's famous trade name and registered marks as defined in Section 43(c) of the federal Trademark Act, 15 U.S.C. §1125(c).

24. Opposer will be damaged by the registration sought herein by Applicant because such registration will support and assist Applicant in the confusing and misleading use of Applicant's designation sought to be registered, and will give color of exclusive statutory rights in Applicant in violation and derogation of the prior superior rights of Opposer.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's designation and prays that Application Serial No. 76/182,417 not be allowed.

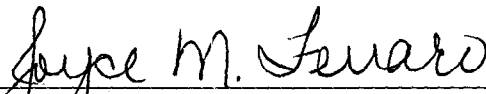
Please recognize as attorneys for Opposer in this proceeding, James W. Dabney, Joyce M. Ferraro, and Melanie Bradley (members of the Bar of the State of New York), and the law firm of Pennie & Edmonds LLP, 1155 Avenue of the Americas, New York, New York 10036.

Please address all communications to Joyce M. Ferraro at the above address.

Respectfully submitted,

Date: April 15, 2003

By:



James W. Dabney

Joyce M. Ferraro

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Attorneys for Opposer

Virgin Enterprises Limited

Form PO-140
Form approved by
Comptroller General U.S.
November 2, 1950

U.S. DEPARTMENT OF COMMERCE
PATENT OFFICE

Express Mail No. **EL 477 836 657 US**

BEFORE USING THIS ORDER FORM
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April 15, 2003

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04-18-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #74

DESCRIPTION OF ARTICLES OR SERVICES TO BE FURNISHED

Re: Virgin Enterprises Limited v. Berry Textile (Shanghai) Co., Ltd.,
In re Serial No. 76/182,471
Published: September 10, 2002

Dear Sir:

Enclosed please find the Notice of Opposition in connection with the above-captioned matter. Please deduct the appropriate amount from our Deposit Account No. 16-1150, to cover the filing fee in the amount of \$300.00, and please deduct any other fees which may be due.

If additional space is needed attach separate sheet.

Joyce M. Ferraro
Joyce M. Ferraro

37,046

Registration No.

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